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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,174	09/24/2003	Carolina H. Henderson	CH-03-01	7005

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EXAMINER
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BOGART, MICHAEL G

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/671,174

Applicant(s)

HENDERSON, CAROLINA H.

Examiner

Michael G. Bogart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-13 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-13 and 15-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

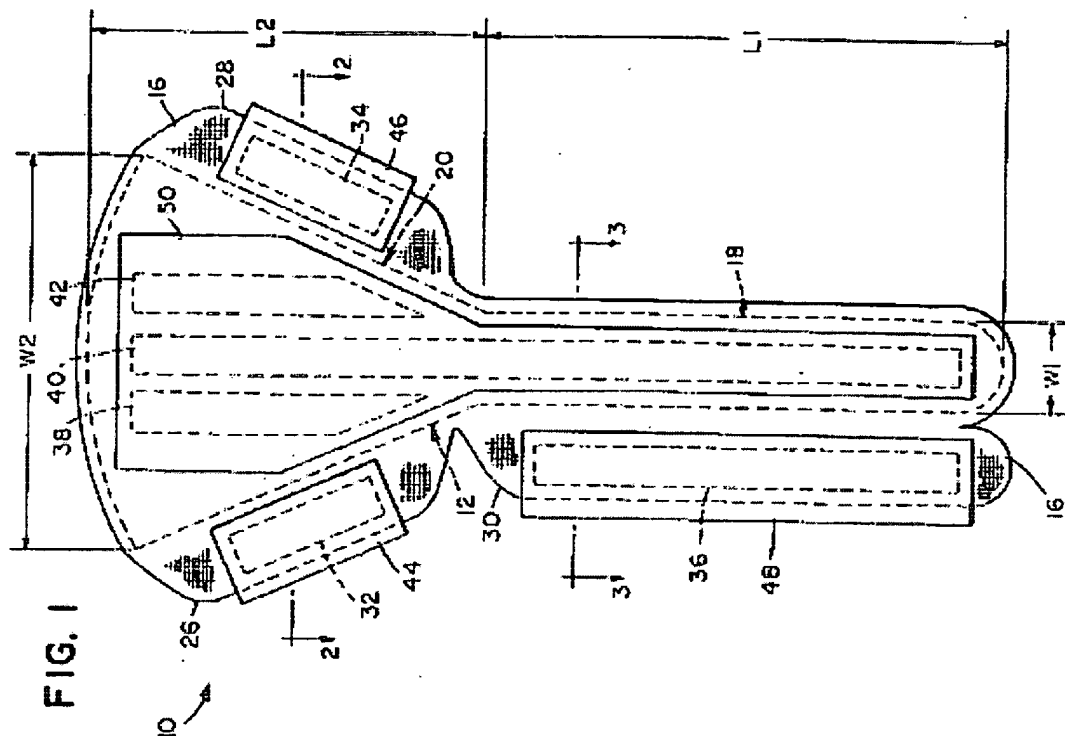
Claims 2-5, 8, 9, 11, 15-17 are rejected under 35 U.S.C. § 102(b) as being anticipated by Sturino (US 5,713,886 A).

Regarding claim 16, Sturino teaches a feminine hygiene article (10) for absorption of bodily fluids, comprising:

an elongated absorbent article (10) having a front end (20), a back end (18), a length (L1 + L2) between said front and back ends (20, 18) sufficient to extend from a point between the user's buttocks to a point beyond the user's urogenital area, a height less than about 2 inches, and a width sufficiently small to fit between the user's buttocks and legs without causing significant discomfort;

wherein said back end (18) is capable of retention between a user's buttocks while said front end extends forward between the user's legs and beyond the user's urogenital area, said back end (18) has a height less than about 2 inches and a width (W1) sufficiently small to be capable of fitting between the user's buttocks and legs without causing significant discomfort and said front end (20) does not include an intravaginal portion (column 2, lines 25-41)(see figure 1, below).

Regarding claim 2, Sturino teaches a soft material that is substantially non-irritating to human skin and membranes in the genital area (column 2, lines 41-67).



Regarding claim 3, Sturino teaches that said material is selected from bonded fabrics, woven fabrics, cellulose, paper, and combinations thereof (column 2, lines 41-67).

Regarding claim 4, Sturino teaches that the article (10) comprises a plurality of layers (22, 24, 14) of said material.

Regarding claim 5, Sturino teaches at least one folded layer (26, 28, 30)(column 3, lines 12-20).

Regarding claim 8, Sturino teaches an article length ( $L1 + L2$ ) between about 6 inches and about 10 inches (column 2, lines 26-41).

Regarding claim 9, Sturino teaches a width (W1) less than about 1.5 inches (column 2, lines 26-41).

Regarding claim 11, Sturino teaches that the article (10) is flexible and can conform to the shape of the body area where it is used (column 4, lines 4-13).

Regarding claim 17, Sturino teaches a feminine hygiene kit comprising:

an elongated absorbent article (10) having a front end (20), a back end (18), a length (L1, L2) between said front and back ends (20, 18) sufficient to extend from a point between the user's buttocks to a point beyond the user's urogenital area, wherein said back end is capable of retention between a user's buttocks while said front end (20) extends forward between the user's legs and beyond the user's urogenital area, said back end (18) has a height less than about 2 inches and a width (W1) sufficiently small to fit between the user's buttocks and legs without causing significant discomfort and said front end (20) does not include an intravaginal portion; and

an absorbent pad (12) held in placed between the user's panties and her urogenital area.

Regarding claim 15, Sturino teaches that the absorbent article is a panty liner (abstract).

Claims 16, 6 and 7 are rejected under 35 U.S.C. § 102(b) as being anticipated by Mills (US 3,143,113).

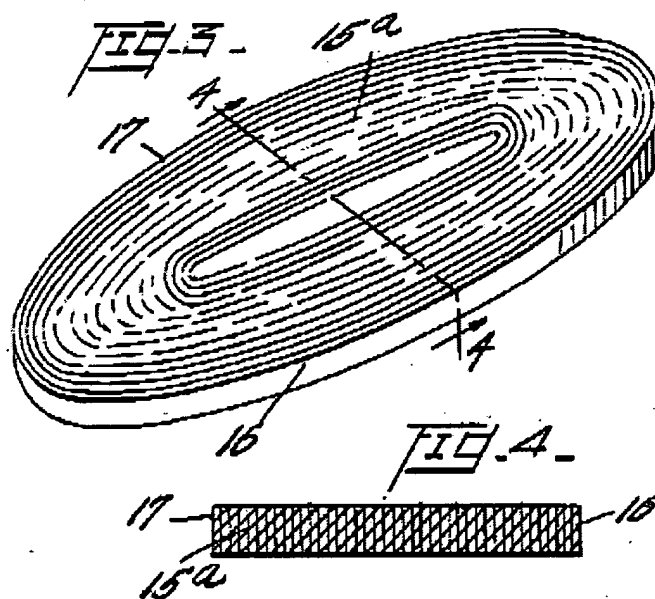
Regarding claim 16 Mills teaches a feminine hygiene article (11) for absorption of bodily fluids, comprising:

an elongated absorbent article (11) having a front end, a back end, a length between said front and back ends sufficient to extend from a point between the user's buttocks to a point beyond the user's urogenital area, a height less than about 2 inches, and a width sufficiently small

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to fit between the user's buttocks and legs without causing significant discomfort (the bandage folds when placed between the buttocks);

wherein said back end is capable of retention between a user's buttocks while said front end extends forward between the user's legs and beyond the user's urogenital area, said back end has a height less than about 2 inches and a folded width sufficiently small to be capable of fitting between the user's buttocks and legs without causing significant discomfort and said front end does not include an intravaginal portion (column 3, lines 27-60)(see figures 3 and 4, below).



Regarding claim 6, Mills teaches that the article comprises a layer (15a) rolled into an elongated coil.

Regarding claim 7, White teaches a device that would be subjected to creasing and twisting forces while being used by a wearer.

***Claim Rejections – 35 USC § 103***

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Mills.

Mills teaches that the device has a depth, height or thickness between 1/4 and 1/2 inches (column 3, lines 27-60).

In the case where the claimed ranges “overlap or lie inside ranges disclosed by the prior art” a prima facie case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990) (The prior art taught carbon monoxide concentrations of “about 1-5%” while the claim was limited to “more than 5%.” The court held that “about 1-5%” allowed for concentrations slightly above 5% thus the ranges overlapped.); *In re Geisler*, 116 F.3d 1465, 1469-71, 43 USPQ2d 1362, 1365-66 (Fed. Cir. 1997) (Claim reciting thickness of a protective layer as falling within a range of “50 to 100 Angstroms” considered prima facie obvious in view of prior art reference teaching that “for suitable protection, the thickness of the protective layer should be not less than about 10 nm [i.e., 100 Angstroms].” The court stated that “by stating that suitable protection’ is provided if the protective layer is about’ 100 Angstroms thick, [the prior art reference] directly teaches the use of a thickness within [applicant’s] claimed range.”). Similarly, a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp.*

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*of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (Court held as proper a rejection of a claim directed to an alloy of “having 0.8% nickel, 0.3% molybdenum, up to 0.1% iron, balance titanium” as obvious over a reference disclosing alloys of 0.75% nickel, 0.25% molybdenum, balance titanium and 0.94% nickel, 0.31% molybdenum, balance titanium.).

MPEP § 2144.05.

Claims 1, 6 and 7 are rejected under 35 U.S.C. § 103 as being unpatentable over White (US 6,890,326 B2) and Pierce *et al.* (US 4,340,058).

Regarding claim 1, White teaches a feminine hygiene article (10) for absorption of bodily fluids, comprising:

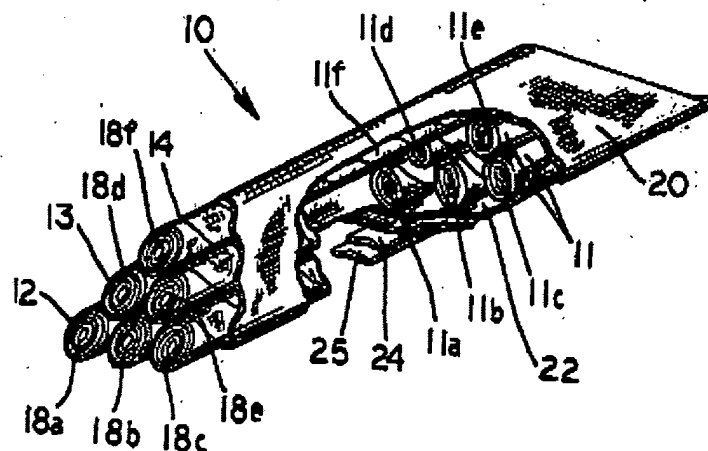
an elongated absorbent article (10) having a front end (54), a back end (14), a length between said front and back ends (54, 14) sufficient to extend from a point between the user's buttocks to a point beyond the user's urogenital area and a width sufficiently small to fit between the user's buttocks and legs without causing significant discomfort;

wherein said back end (14) is capable of retention between a user's buttocks while said front end extends forward between the user's legs and beyond the user's urogenital area, said back end (14) has a height less than about 2 inches and a width sufficiently small to be capable of fitting between the user's buttocks and legs without causing significant discomfort and said front end (54) does not include an intravaginal portion (Abstract)(see figure 5, below).





Pierce *et al.* teach an absorbent article (10) that uses coiled fabric to form absorbent cylinders (see figure 1, below).



At the time of the invention, it would have been obvious to one of ordinary skill in the art to select the rolled fabric of Pierce *et al.* to make the absorbent cylinder of White because that would be a ready way to use available flat sheets of gauze for this purpose.

Regarding claim 7, White teaches a device that would be subjected to creasing and twisting forces while being used by a wearer.

### ***Response to Amendment***

The affidavit filed on 12 October 2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the White reference.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the White reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). Applicants assert that they conceived of the instant invention as early as 1986 but have not provided any evidence of this assertion.

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the White reference. Applicants assert in their affidavit that they had the completed invention in writing on 19 June 2002. Applicants have not provided a copy of this or any other evidence to support this assertion.

### ***Response to Arguments***

Applicant's arguments filed 12 October 2005 have been fully considered but they are not persuasive.

In response to applicant's argument that the absorbent article's rear portion is formed to be inserted between a users buttocks, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The long rear tail of Sturino is capable of being inserted in a wearers buttocks. Furthermore, it is designed to be attached to the inner surface of a thong type undergarment, which itself has a rear portion that is retained between a user's buttocks while in use.

In response to applicant's argument that the devices of Pierce or Champaigne, Jr. are not analogous to the instant invention and can not be worn in a similar manner, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

These references have been applied as secondary references which have one or more discrete features which are added to the teaching of the respective primary references.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bogart whose telephone number is (571) 272-4933.

In the event the examiner is not available, the Examiner's supervisor, Tatyana Zalukaeva may be reached at phone number (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300 for formal communications. For informal communications, the direct fax to the Examiner is (571) 273-4933.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-3700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Michael Bogart

6 January 2006

**TATYANA ZALUKAEVA**  
**SUPERVISORY PRIMARY EXAMINER**

A handwritten signature in black ink, appearing to read "Tatyana", written in a cursive style.